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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,215	10/15/2001	Luis J. Rodriguez		4475

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EXAMINER

GARBE, STEPHEN P

ART UNIT	PAPER NUMBER
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3727

8

DATE MAILED: 06/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,215

Applicant(s)

RODRIGUEZ, LUIS J.

Examiner

Stephen Garbe

Art Unit

3727

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. The amendment filed May 20, 2002, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is the incorporation by reference of application number 09/130,534.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by "obtainable upon folding of said body" in lines 5 and 6. It appears that the two recited "sections" are present regardless of whether the body is folded or not. Thus, it is unclear how the sections are "obtained" upon folding of the body.

4. Claims 29-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are indefinite for the same reason as claim 28 because they include all of the limitations of claim 28.

5. Applicant is advised that should claim 36 be found allowable, claim 38 will be objected to under 37 CFR 1.75 as being a duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object

to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 23 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Schieman, United States Patent No. 2,367,440. Schieman discloses all claimed structural features including at least one flap having a layer of adhesive 3 thereon and a body having at least one section contiguous to the flap, the section having a layer of adhesive inhibitor 4 thereon. The term “form” does not impart any structure to the claimed invention and does not define over Schieman.

8. Claim 42 is rejected under 35 U.S.C. 102(b) as being anticipated by Schieman, United States Patent No. 2,367,440. Schieman discloses all claimed structural features including a “folding area” (not numbered) located between coatings 3 and 4, which “folding area” produces a flap and a body. Schieman further discloses a “folding area” (not numbered) located at the bottom of the envelope as viewed in Figure 1 which produces an additional panel. Schieman’s envelope is capable of bearing text or graphic indicia and of performing all other claimed function. In addition, the term “form” does not impart any structure to the claimed invention and does not define over Schieman.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440, as applied to claim 23, in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Schieman's devices in series meet the requirements of claims 24 and 25.

11. Claims 23, 28, 29, 35, 36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440 in view of Wilbur, United States Patent No. 2,384,223. Schieman discloses all structural features except for the release substance recited in claim 28. Schieman's coating 4 is a repellent coating that does not adhere to the pressure sensitive adhesive 3. Wilbur discloses a release substance 24 which may be weakly adherent to pressure sensitive adhesive 26. It would have been obvious to substitute a release substance, as taught by Wilbur at 24, for Schieman's repellent material 4 because a weakly adherent material would have served to maintain Schieman's flap in place prior to use. The term "form" does not impart any structure to the claimed invention and does not define over Schieman.

12. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440 in view of Wilbur, United States Patent No. 2,384,223, as applied to claim 23, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Schieman's devices that are adjacent to one another meet the requirements of claims 24 and 25.

13. Claims 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440 in view of Wilbur, United States Patent No. 2,384,223, as applied to claim 28, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Schieman's devices that are adjacent to one another meet the requirements of claims 24 and 25.

14. Claims 37 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440 in view of Wilbur, United States Patent No. 2,384,223, as applied to claim 35, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a

cost effective way of mass producing the devices. Any two of Schieman's devices that are adjacent to one another meet the requirements of claim 37.

15. Claims 37 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440, as applied to claim 35, in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Schieman's devices in series meet the requirements of claim 37.

16. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440 in view of Wilbur, United States Patent No. 2,384,223. Wilbur discloses a release substance 24 which may be weakly adherent to pressure sensitive adhesive 26. It would have been obvious to substitute a release substance, as taught by Wilbur at 24, for Schieman's repellent material 4 because a weakly adherent material would have served to maintain Schieman's flap in place prior to use. Schieman's envelope is capable of bearing text or graphic indicia and of performing all other claimed function. In addition, the term "form" does not impart any structure to the claimed invention and does not define over Schieman.

17. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440, as applied to claim 42, in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of

Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Schieman's devices in series meet the requirements of claim 43.

18. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schieman, United States Patent No. 2,367,440 in view of Wilbur, United States Patent No. 2,384,223, as applied to claim 42, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a plurality of Schieman's devices in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Schieman's devices in series meet the requirements of claim 43.

19. Claims 23, 35, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United States Patent No. 2,384,223 or Schieman, United States Patent No. 2,367,440. Johnson discloses a form having all claimed features except for the claimed adhesive inhibitor. Note flaps 8, 8, and 9 which contain adhesive and are folded onto panel 4, but not sealed thereto. It would have been obvious to provide panel 4 of Johnson with adhesive inhibitor adjacent to flaps 8, 8, and 9, as taught by either Wilbur at 24 or Schieman at 4, because the inhibitor would have prevented unintentional sealing of flaps 8, 8, and 9 to the form.

20. Claims 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United States

Patent No. 2,384,223 or Schieman, United States Patent No. 2,367,440, as applied to claim 23, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to produce a plurality of Johnson's forms in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Johnson's forms in series meet the requirements of claim 24.

21. Claims 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of Wilbur, United States Patent No. 2,384,223. Johnson discloses a form having all claimed features except for the claimed release substance and pressure sensitive adhesive. Note flaps 8, 8, and 9 which contain adhesive and are folded onto panel 4, but not sealed thereto. It would have been obvious to provide panel 4 of Johnson with a release substance adjacent to flaps 8, 8, and 9, as taught by either Wilbur at 24, because the release substance would have prevented unintentional sealing of flaps 8, 8, and 9 to the form. It would have been further obvious to substitute pressure sensitive adhesive, as taught by Wilbur, for Johnson's adhesive because pressure sensitive adhesive is more convenient to use.

22. Claims 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of Wilbur, United States Patent No. 2,384,223, as applied to claim 28, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to produce a plurality of Johnson's forms in series, separated by lines of perforations, as taught by Stenner, because doing

so is a cost effective way of mass producing the devices. Any two of Johnson's forms in series meet the requirements of claims 30 and 31.

23. Claims 35, 36, 38, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of Wilbur, United States Patent No. 2,384,223. Johnson discloses a form having all claimed features except for the claimed release substance and pressure sensitive adhesive. Note flaps 8, 8, and 9 which contain adhesive and are folded onto panel 4, but not sealed thereto. It would have been obvious to provide panel 4 of Johnson with a release substance adjacent to flaps 8, 8, and 9, as taught by either Wilbur at 24, because the release substance would have prevented unintentional sealing of flaps 8, 8, and 9 to the form. It would have been further obvious to substitute pressure sensitive adhesive, as taught by Wilbur, for Johnson's adhesive because pressure sensitive adhesive is more convenient to use.

24. Claims 37 and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United States Patent No. 2,384,223 or Schieman, United States Patent No. 2,367,440, as applied to claim 35, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to produce a plurality of Johnson's forms in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Johnson's forms in series meet the requirements of claim 37.

25. Claims 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson, United States Patent No. 3,027,067 in view of either Wilbur, United States Patent No. 2,384,223 or Schieman, United States Patent No. 2,367,440, as applied to claim 42, and further in view of Stenner, United States Patent No. 5,607,100. It would have been obvious to produce a plurality of Johnson's forms in series, separated by lines of perforations, as taught by Stenner, because doing so is a cost effective way of mass producing the devices. Any two of Johnson's forms in series meet the requirements of claim 43.

26. Applicant's arguments filed with the reply of May 20, 2002, have been fully considered but they are not persuasive. Applicant's arguments relating to the meaning of the term "form" is not persuasive because the original "definition" on page 1 is broad. On page 15 of the reply, Applicant quotes from that definition, but neglects to include the last sentence, which states, "A form can also be described as a mailer or any other equivalent term." Thus, the argument that the original definition in the specification precludes an envelope is not persuasive because an envelope is a mailer and because the term "envelope" is an equivalent term. This argument is further unpersuasive because each of Applicant's disclosed embodiments has the construction of an envelope, i.e., each includes panels and flaps secured together in a manner which forms at least one pocket into which contents can be placed. Arguing that the disclosed envelope constructions are not envelopes, but "forms" because no content item is included is an argument relating only to intended use. A claim to an article must define over the prior art in terms of structure, not just function or intended use.

Applicant's arguments relating to the meaning of "correspondence" are not persuasive because a "form" as originally defined in the specification is not limited to "correspondence" as set forth in the preceding paragraph.

On page 31, Applicant argues that a self contained form is something completely different than Schieman's envelope. However, He does not point out what that difference is. If the claimed form is structurally different from Schieman's envelope, Applicant is requested to point out that difference.

The arguments relating to Fisher are moot since Fisher is not being applied as a reference.

The arguments on page 39 relating to structural differences between Schieman and the present invention are not persuasive because the claims do not preclude them. That is, even though Schieman's panels and flaps are arranged differently than Applicant's disclosed forms, they are not arranged differently than Applicant's claimed forms.

Affidavit 1 and its attachments have been considered but are not persuasive because they present no factual evidence. This affidavit is mostly a "rehash" of the arguments presented in the reply. The attachments do not establish commercial success because they do not contain any sales figures for the claimed invention and because they do not establish a nexus between sales, or increased sales, and the claimed invention.

Affidavit 2 and its attachments have been considered but are not persuasive because they present no factual evidence.

Affidavit 3 has been considered but is not persuasive because it presents no factual evidence. The results of an opinion poll do not constitute facts and cannot be relied upon as secondary evidence of patentability.

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

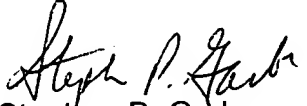
28. Any inquiry concerning this application or proceeding should be directed to Stephen Garbe who can be reached at 703-308-1207. The examiner can normally be reached Monday-Thursday between the hours of 7:15 and 4:45 and alternate Fridays between the hours of 7:15 and 3:45.

29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee Young, can be reached on 703-308-2572.

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30. The fax phone numbers for Technology Center 3700 are 703-872-9302 for papers filed in response to a non-final Office Action and 703-872-9303 for papers filed in response to a Final Office Action.

31. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-1148.


Stephen P. Garbe
Primary Examiner
Group 3720